

REMARKS/ARGUMENTS

Claims 1 to 22 are pending in this application. Claims 1-22 are rejected. Claims 3-7 and 17 are objected to. Claim 1 has been amended. Claim 19 has been cancelled.

By the present amendment claim 1 has been amended by deleting the term "cyano" from the definition of "R₁" and the term "R_g" from the definition of "W". In addition, claim 1 has been amended by providing that, in the definition of "Z", the pyrrolyl, piperidyl and morpholinyl rings are attached to the rest of the molecule through a carbon atom on the ring of the heterocyclic radical.

Claims 1, 18, 19 and 22 are rejected under 35 USC §112 as being indefinite on the ground that the metes and bounds of the terms "ester" and "amide" are unknown. The Examiner has maintained that there is no definition for these terms in the specification that warrants applicants' explanation that these terms refer to pharmaceutically acceptable masking groups or protecting groups.

Applicants' claims are drawn to compounds of formula (I)(B) or a pharmaceutically acceptable salt, amide, ester or hydrate thereof. The Examiner's attention is directed to the specification beginning at page 23, line 30, and ending on page 32, wherein a list of pharmaceutically acceptable protecting groups, including esters (p. 26) and amides (p. 29) is given. It is submitted that the specification clearly discloses that the terms in question refer to pharmaceutically acceptable masking groups or protecting groups.

Reconsideration of the rejection of claims 1, 18, 19 and 22 under 35 USC §112 is courteously requested.

Claims 1, 2, 8, 10, 12-16, 20 and 21 are rejected under 35 USC §102(b) as being anticipated by Joshi *et al.*, Chem Abstracts 105: 190834. The Examiner has concluded that "the instantly claimed compounds read on the reference compound". In making the rejection, the Examiner specifically refers to the CAPLUS Computer search report and the compounds having RN 104815-95-4, 104843-80-3, 104815-92-1, 104815-93-2 and 104815-94-3. The reference is an abstract of a paper by Krishna C. Joshi *et al.*, J. Indian Chem. Soc., vol LXII, May 1995, pp. 388-390 (copy enclosed). All of the compounds in the Joshi *et al.* paper have an -OCH₂CH₂NR₂ group attached to the phenyl ring. NR₂ is defined as morpholinyl, piperolyl and pyrrolyl. In each instance the heterocyclic ring is attached to the alkylene group through the ring nitrogen. By the present amendment the substituent "Z" has been amended to provide that when "Z" is morpholinyl, pyrrolyl or piperolyl, the heterocyclic ring is attached to the rest of the molecule via a ring carbon. Support for this amendment is found in the Examples (see, for example, Examples 4 and 6). It is believed that the claims as amended do not read on the reference compounds.

Applicants' attorney wishes to correct a statement made in the prior amendment regarding the Joshi *et al.* reference. On page 9 of the prior amendment applicants' attorney stated that "if it is read in the ordinary meaning, non-F containing compounds are disallowed by the terms of the description". This conclusion is incorrect.

Reconsideration of the rejection of claims 1, 2, 8, 10, 12-16, 20 and 21 under 35 USC §102(b) as being anticipated by Joshi *et al.* is courteously requested.

Claims 1, 2, 8, 10, 12, and 20 are rejected under 35 USC §102(b) as being anticipated by Buu-Hoi *et al.*, Chem Abstracts 68: 114411. The Examiner has concluded that the instantly claimed compounds read on the reference compound. Specific reference is made to CAPLUS computer search report and the compound having RN 18121-71-6. The reference compound is indole, 2,2'-(4,4'-biphenylene)di. The overlap appears to occur when "Rg" in the definition of "W" is phenylene. By the present amendment "Rg" has been deleted. It is believed that the claims as amended do not read on the indole biphenyl compound.

Reconsideration of the rejection of claims 1, 2, 8, 10, 12 and 20 as being anticipated by Buu-Hoi *et al.* under 35 USC §102(b) is courteously requested.

Claims 1, 2, 8, 10-12, 14-16, 20 and 21 are rejected under 35 USC §102(b) as being anticipated by Suh *et al.*, Chem Abstracts 69: 77112. The Examiner has concluded that the instantly claimed compounds read on the reference compound. The reference compound is indole-3-carbonitrile, 2-[p-[2-(diethylamino)ethoxy]phenyl]-5,6-dimethoxy. The Chem Abstract reference refers to U.S. patent No 3,370,063 (copy enclosed) which issued to John T. Suh in 1968. Applicants believe that the reference compound is described in Example XX of the patent. By the present amendment the cyano group has been deleted from the definition of "Z" in claim 1. It is believed that the claim as amended does not read on the reference compound.

Reconsideration of the rejection of claims 1, 2, 8, 10-12, 14-16, 20 and 21 under 35 USC §102(b) as being anticipated by Suh *et al.* is courteously requested.

Claims 1, 2, 8-16, 20 and 21 remain rejected under 35 USC 103(a) as being unpatentable over Neuenschwander *et al.* (US 5,385,912). It is submitted that some of applicants' claimed compounds fall within the broad generic disclosure in the reference. However, none of applicants' claimed compounds is specifically disclosed in the reference. Applicants wish to point out that the compounds disclosed and claimed in Neuenschwander *et al.* are described as being useful for lowering serum cholesterol levels. Applicants' claimed compounds are useful in treating or preventing disorders and conditions mediated by the histamine H₃ receptor. As such they are useful in treating obesity, allergic rhinitis, substance

abuse, bipolar disorders, manic disorder and depression. The utility for applicants' claimed compounds is not disclosed in the reference. In view of the fact that none of applicants' compounds is specifically disclosed in the reference and in view of the fact that applicants' claimed utility is not disclosed in the reference, it is submitted that applicants are entitled to claim new compounds having applicants' claimed utility.

Reconsideration of the rejection of claims 1, 2, 8-16, 20 and 21 under 35 USC 103(a) as being unpatentable over Neuenschwander *et al.* is courteously requested.

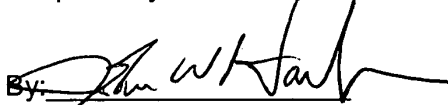
Claims 1, 2, 8, 10-16, 20 and 21 are rejected under 35 USC 102(b) as anticipated by Connor (WO98/06703). In the Connor reference an amino group (NR₆R₇) is attached directly to the phenyl ring or through an alkylene group (CH₂)₀₋₃. The Examiner has pointed out that the substitution on the phenyl ring, (CH₂)₀₋₃-NR₆R₇), corresponds to "-R₉Z" in applicants' claims wherein "R" is defined as alkylene and "Z" can be -NR₁₁R₁₂ wherein each of R₁₁ and R₁₂ is selected from H, alkyl etc. By the present amendment the term "R₉" has been deleted from the definition of "W". It is believed that the claims as amended do not read on the reference compound.

Reconsideration of the rejection of claims 1, 2, 8, 10-16, 20 and 21 under 35 USC 102(b) as anticipated by Connor is courteously requested.

Claims 3-7 and 17 are objected to as being dependent upon a rejected base claim but would be allowable if re-written in independent form. As a result of the amendments herein being made to the claims, it is believed that all of the claims are now in condition for allowance. No need is seen, therefore, to write these claims in independent form.

In view of the above discussion and the amendments made herein to the claims, it is believed that all of the outstanding objections and rejections have been removed. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

By: 

John Harbour

Reg. No. 31,365

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2169
Date: December 11, 2003